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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,289	10/14/2003	Matthew P. Dugas	14505.01	9823

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EXAMINER

SIEFKE, SAMUEL P

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/685,289	Applicant(s) DUGAS, MATTHEW P.	
	Examiner Samuel P. Siefke	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-21,24-43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21,24-43 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 1-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group I, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/18/05.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 43 provides "a molecular information gathered using the method of claim 45" but, since the claim does not set forth any steps involved in the information gathering method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 43 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19-21,24-43,45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/461,307. Although the conflicting claims are not identical, they are not patentably distinct from each other because 10/461,307 claims boring whereas the current application claims drilling the nano-scale channel. It would have been obvious to one having an ordinary skill in the art to recognize that boring and drilling are equivalents.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19, 24,25-43 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Branton et al. (USPN 6,627,067).

Branton discloses a method of forming a membrane structure for evaluation of a polymer molecule that comprises forming a cavity in the membrane. The membrane surface is progressively thinned from the cavity free surface of the substrate until it intersects with the cavity to form an aperture. In fig. 16a, a nanopore gap can be seen, this corresponds to the aperture being of nano-scale size (also col. 8, lines 50-57) In column 11, lines 47, Branton discloses a micro-fabrication method. "Referring to FIG. 4, in an example microfabrication process provided by the invention for forming an aperture in a membrane, a starting substrate 130, e.g., a silicon wafer is provided, as shown in FIG 4A. A selected membrane material, e.g., silicon nitride, is provided as coating layers 132, 134 on the upper and lower surfaces, respectively, of the wafer. In one example, a silicon-rich, low-stress, silicon nitride layer of about 50 nm in thickness is deposited on the silicon wafer by conventional chemical vapor deposition (CVD) processing." Branton discloses that while the aperture is being thinned, feedback of the

apertures diameter can be measured in real time so the diameter of the aperture can be controlled in a precise manner (col. 14, lines 13-42; col. 13, lines 56-65).

The aperture walls are made up of an insulating material. Means for causing the monomers of a candidate polymer molecule to linearly traverse the aperture in single-file order is provided, whereby the polymer molecule interacts with the aperture. A detector is used to identify time-dependent or monomer-dependent interactions of the molecule with the aperture. Additionally, an amplifier or recording mechanism may be used to detect changes in the ionic or electronic conductance across the aperture as the polymer traverses the opening (col. 7, line 59-col. 8, line 6). A first and second electrodes adjacent to or bordering the aperture serve as detectors. The electrodes are positioned so as to monitor the candidate polymer molecules that translocate the aperture (col. 8, lines 21-25). The aperture of the invention is located in a solid-state membrane. The solid state membrane is chemically inert and/or resistant. Exemplary materials include, silicon nitride (Si_3N_4), alumina (Al_2O_3), and silica (SiO_2), or plastics such as Teflon or elastomers such as two-component addition-cure silicone rubber. The aperture may be sized to permit interaction of a single-stranded or double-stranded molecule, i.e., the aperture is of a diameter that is similar to the atomic width of the polymer molecule of interest. The membrane may be conducting, in which case, the walls of the aperture may be coated with an insulating layer (col. 8, lines 38-67). An insulating layer is then deposited on the walls of the aperture that is suitable to provide the desired insulating properties and the desired final channel diameter dimensions. The solid-state membrane containing the aperture is

provided with a conductive, i.e., metallic, layer or thin film that serves as an electrode. The conductive regions are in close proximity to the aperture for high local sensitivity to conductance or electronic variations in both the transverse (along the channel) or longitudinal (across the channel opening) directions. The electrodes may be used in conjunction with either ionic or electronic sensing, as is described herein. Branton further discloses a conductive layer on the membrane that is separated into two electrodes by the formation of the aperture and forming conductive layer above and below the membrane thereby forming four electrodes upon forming the aperture. See also (fig. 5a, 8a, 8b, 15; col. 3, 4, 7, 8, 9, 13, 14, 15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Branton et al. (USPN 6,627,067) in view of Nisch et al. (USPN 6,218,663).

Branton discloses a method of forming a membrane structure for evaluation of a polymer molecule that comprises forming a cavity in the membrane as seen above.

Branton does not teach drilling the nano-scale channel by a TEM instrument or a SCRIBE.

Nisch teaches ion etching for local thinning of a sample in transmission electron microscope (TEM) with simultaneous electron microscopic observation (abstract). SCRIBE uses the same beam of ions as TEM and therefore is an equivalent. It would have been obvious to one having an ordinary skill in the art to modify the method of Branton to employ TEM to drill the aperture because it produces simultaneous drilling and electron microscope observation so that one can observe while drilling. This provides superior and perfect thinning of a membrane.

Response to Arguments

Applicant's arguments filed 11/18/05 have been fully considered but they are not persuasive. Applicant argues, "Branton fails to teach or suggest drilling a nano-scale channel through a self supporting portion of the thin film and measuring the channel, wherein the drilling and measuring are performed during a single presentation to an instrument." The Examiner disagrees with the above statement because claim 19 only

includes the limitation of drilling the channel and measuring the channel as being done in one single presentation. Branton discloses that while the aperture (channel) is being thinned (drilled), feedback of the apertures diameter can be measured in real time so the diameter of the aperture can be controlled in a precise manner (col. 14, lines 13-42). Claim 19 does not include etching a hole through the support substrate as being performed during a single presentation to an instrument. Therefore each and every limitation of claim 19 is anticipated by Branton.

The Examiner would like to further point to page 8 of the Applicant's specification, "After thin film 60 has been generated on silicon substrate 55, a hole or window 65 is etched into the silicon substrate 55 and the lower layer of the thin film using standard lithography techniques, such as wet etching. Such techniques will remove the silicon in the desired area but will have no effect on thin film 60. Thus, over the area defined by lithography hole 65, thin film layer 60 becomes self-supporting as illustrated in Figure 2C. Subsequently, a channel 75 (as illustrated in Figure 2E) is cut through thin film 60 with a focused ion beam (FIB) 70 or other suitable precision milling device such as electron beam lithography, neutral particle beam, charged particle beam, x-ray, or other suitable mechanism." Then on page 9, "Thus, one technique to form appropriately sized nano scale apertures is to use the TEM to drill the nanopore and then to measure the nanopore, all in one sample presentation to the TEM instrument. Figs. 13 and 14 show nanopores made with a TEM drill and imaged in-situ with the same TEM in a one step process." The etching process of the Applicant's

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specification is independent (or different presentation to an instrument) ^{of} ~~from~~ the drilling and measuring of the channel.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

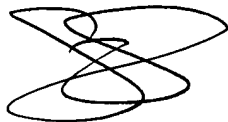
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P. Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sam P. Siefke



January 31, 2006


Jill Warden
Supervisory Patent Examiner
Technology Center 1700